

REMARKS

A. Claims 11 and 12 Are Novel over Jalbert.

Claims 11 and 12 stand rejected as anticipated by Jalbert (US 3,708,905). Claim 11 has been amended to recite placing bait “designed to kill rodents” in the plastic bait station. Jalbert discloses baiting a lobster trap, and does not specify a particular bait, much less a bait that is designed to kill rodents. The rejection is overcome and should be withdrawn.

B. Claims 11 and 12 Are Patentable over Pruitt and Loebbert.

Claims 11 and 12 stand rejected as obvious over Pruitt (US 5,897,018) and Loebbert. Neither Pruitt nor Loebbert discloses or suggests a sidewall with a doorway that leads to an interior as now recited in claim 11. Accordingly, the rejection is overcome and should be withdrawn.

C. Claim 11 Is Patentable over Pruitt and Griswold.

Claim 11 stands rejected as obvious over Pruitt and Griswold (US 6,508,377). Neither Pruitt nor Griswold discloses or suggests a sidewall with a doorway that leads to an interior as now recited in claim 11. Accordingly, the rejection is overcome and should be withdrawn.

D. Claim 12 Is Patentable over Pruitt and Griswold and Loebbert.

Claim 12 stands rejected as obvious over Pruitt and Griswold and Loebbert (US 5,150,810). Loebbert fails to cure the deficiency of Pruitt and Griswold. Accordingly, the rejection is overcome and should be withdrawn.

E. Claims 11 and 12 Are Patentable over Crossen and Pruitt or Morell.

Claims 11 and 12 stand rejected as obvious over Crossen (US 6,513,283) and Pruitt or Morell (US 3,343,744). The Office admits that Crossen fails to disclose placing pre-formed weighted material in the receptacle. But it contends that “[i]t would have been obvious . . . to modify the method of Crossen such that pre-formed weighted material is placed in the receptacle

in view of Pruitt or Morell et al. in order to provide the user with the ability to fill the receptacle at the time of use with the desired type of material having the density property necessary to weight the bait station and keep it in place.” Action at 8.

1. The asserted combination of Crossen and Pruitt fails.

a. Crossen does not disclose a receptacle.

The outside of weight 120 of Crossen is not a receptacle. As explained in the last response, the outer portion of weight 120 without the denser, heavier section 123 is a ring, and a ring is not a receptacle because it has no bottom to support anything placed in it. The Office states, “the Crossen receptacle (120) completely surrounds and circumscribes the weight (123) therein and it is unclear to the Examiner how applicant came to the conclusion that the outer portion (120) of Crossen came to be categorized as an outer ring.” Action at 11. Here is how Applicant came to that conclusion: Crossen describes the length, width and thickness of the weight (“The weight 120 is 11 5/8 inches in length, 11 5/8 inches in width, and has a thickness of 1 1/8 inches.” Col. 3, lines 43-44), but only provides the length and width dimensions (not the thickness) of center section 123 (“The weight 120 has a 3¼ inches x 8 5/8 inches center section 123 that is harder/more dense than the periphery of the weight 120.” Col. 3, lines 46-48). Applicant submits that one of ordinary skill in the art would understand the center section to have the same thickness as the weight itself because Crossen specified the differences between the dimensions of the two and thickness was not listed. Accordingly, Applicant’s argument stands, and the rejection is overcome for this reason alone.

b. Crossen’s weight addresses the motivation the Office identifies, and Crossen would have to be substantially redesigned.

Second, and as pointed out in the last response, eliminating the heavier, denser section 123 of weight 120 is not obvious because it would change the principle of operation of Crossen’s

invention, which he contends is the overall weight itself (especially the central section 123 the Office advocates eliminating), and/or render Crossen unsuitable for its intended purpose. Crossen explains that the denser, heavier section 123 of his weight is important because it is the portion of the weight that is directly coupled to the bait station and because it vastly improves the anchoring characteristics of his weight. *See* col. 2, lines 5-8 (The portion of the weight that is directly coupled to the bait station is denser than the remaining portion of the weight. This increased hardness at the point of attachment ensures a strong connection.) (emphasis added); col. 3, lines 46-55 (“The solid section **123** centralizes the weight distribution of the weight **120** which vastly improves the anchoring characteristics of the weight **120**.”) (emphasis added).

The Office has failed to address these specific cited portions of Crossen. Instead, the Office replies “that it is possible to substitute the receptacle [which, as Applicant pointed out, does not exist] for adjustably receiving pre-formed weighted material therein for the non-adjustable, integrally formed receptacle and weight combination of Crossen for the purpose of allowing the user to place the desired amount of weight inside the receptacle versus the single unit weighted amount as taught by the device of Crossen.” Action at 12 (emphasis added). However, there are no facts supporting the Office’s position. *See Ex parte Koelzer*, Appeal No. 2009-005518, slip op. at 4 (B.P.A.I. Dec. 15, 2009) (non-binding) (“[T]he examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions, or hindsight reconstruction to supply deficiencies in the factual basis.”) (citation omitted).

Just because it is *possible* to combine references does not render the combination obvious unless, as *KSR* makes clear, there is a logical reason to do so. *See Ex parte Brouwer*, Appeal No. 2009-006169, slip op. at 5-6 (B.P.A.I. Sep. 24, 2009) (non-binding). Here, no such logical

reason exists. If Crossen was silent about his weight, the Office's rationale *might* make sense. However, that is not the case. In addition to the Crossen citations identified above, Crossen explains that the specially-configured weight is his invention:

The present invention relates to rodent bait stations and, more particularly, to specially configured weights for securing rodent bait stations. The rodent bait station weight prevents the accidental and incidental moving or tipping over of a bait station. (Col. 1, lines 11-15).

The invention is a tough, durable rodent bait station weight to anchor a bait station firmly in place and thereby preventing the tipping over of the bait station and the spilling of the bait station's toxic contents. (Col. 1, line 66 – col. 2, line 2).

The present invention, as depicted in FIGS. 1-5, is a configured weight 100, 120 that is sized and dimensioned to secure a rodent bait station 104, 128 thereby preventing the bait station 104, 128 from tipping over and spilling its toxic contents. (Col. 2, lines 55-59).

As all of these citations make clear, Crossen's specially-designed weight already satisfies the need on which the Office relies (i.e., the need for "the desired amount of weight"). *A problem that a primary reference has already solved is not one that can support a finding of obviousness.* See *Ex parte Rinkevich*, Appeal No. 2007-1317, slip op. at 8-9 (B.P.A.I. May 29, 2007) (noting that "the problem proffered by the Examiner is already solved" by the primary reference, and explaining that "a person of ordinary skill in the art having common sense at the time of the invention would not have reasonably looked at [a secondary reference] to solve a problem already solved by [the primary reference]."). *Furthermore, substantially redesigning Crossen to eliminate what Crossen considers his invention is a nonobvious modification.* See *Ex parte Greenwald*, Appeal No. 2008-004685, slip op. at 6-7 (B.P.A.I. June 30, 2009) (non-binding) (agreeing with appellants that examiner's proposal to substitute a slot from one reference for a raised portion of the primary reference would have require additional modifications to the primary reference resulting in a nonobvious "substantial reconstruction and

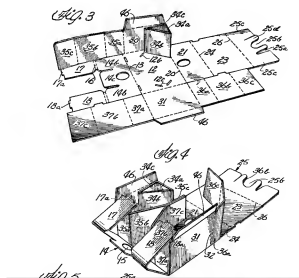
redesign”); *see also Ex parte Farbroth*, Appeal No. 2008-4799, slip op. at 12-14 (B.P.A.I. Feb. 24, 2009) (non-binding) (reversing an obviousness rejection premised on the replacement of the primary reference’s lotion with the gel of a secondary reference because doing so “would eliminate a critical function” of the primary reference’s product).

Accordingly, the rejection is overcome for at least these additional reasons.

2. The asserted combination of Crossen and Morrell fails.

This rejection fails for similar reasons to why Crossen plus Pruitt fails.

First, the Office admits that it is not relying on Morrell for anything except “its capability of allowing the user to fill a receptacle with pre-formed weighted material as an improvement over the single piece weight and receptacle combination taught by Crossen and that by allowing the user to adjust the contents of the receptacle in the device of Morrell will provide the user with some measure of adjustability in terms of how much weight and how dense a material may be loaded into the receptacle.” Action at 12-13. Thus, for this rejection to make any sense, Crossen’s “receptacle” must remain (i.e., the outer ring of 120 without heavier, denser section 123) because Morell fails to disclose or suggest a bait station that is separate from but securable to a receptacle. Instead, Morell discloses a foldable box:



As these figures show, Morrell's compartments are inside the bait station, not secured to them with protrusions that extend up through the bottom of the bait station. In fact, the claimed configuration is the antithesis of Morrell's foldable construction. This is clear from reviewing the first column of Morrell's patent. *But, as explained above, a ring is not a receptacle, so the rejection fails because not all of the limitations are taught or suggested.*

Second—setting aside the lack of the claimed receptacle—it would not be obvious to eliminate the heavier, denser section 123 of weight 120 because it would change the principle of operation of Crossen's invention, which he contends is the overall weight itself (especially the central section 123 the Office advocates eliminating), and/or render Crossen unsuitable for its intended purpose. Crossen explains that the denser, heavier section 123 of his weight is important because it is the portion of the weight that is directly coupled to the bait station and because it vastly improves the anchoring characteristics of his weight. See col. 2, lines 5-8; col. 3, lines 46-55. Crossen also explains that the specially-configured weight is his invention. Col. 1, lines 11-15; col. 1, line 66 – col. 2, line 2; col. 2, lines 55-59. *Substantially redesigning Crossen to eliminate what Crossen considers his invention is a nonobvious modification.* See *Greenwald*, slip op. at 6-7 (agreeing with appellants that examiner's proposal to substitute a slot from one reference for a raised portion of the primary reference would have require additional modifications to the primary reference resulting in a nonobvious "substantial reconstruction and redesign"); see also *Farbrot*, slip op. at 12-14 (reversing an obviousness rejection premised on the replacement of the primary reference's lotion with the gel of a secondary reference because doing so "would eliminate a critical function" of the primary reference's product).

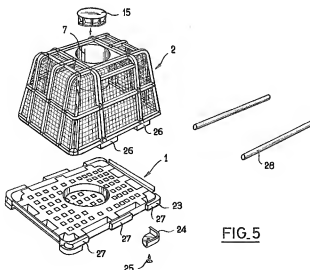
Accordingly, the rejection is overcome and should be withdrawn.

F. Claims 11 and 12 Are Patentable over Crossen and Faucillon.

Claims 11 and 12 stand rejected as obvious over Crossen and Faucillon (US 4,486,973). The Office has failed to state a *prima facie* case of obviousness.

As it did in the last Action, the Office states on page 8 that “Crossen does not disclose the plastic bait station having a bottom with openings [only one or more openings is claimed] or a receptacle having protrusions or placing preformed weighted material in the receptacle.” As it did in the last Action, the Office then states that it would have been obvious to fix these deficiencies “in view of Faucillon in order to provide a plurality of attachment points for the bait station and receptacle to more evenly hold the separate bait station and receptacle together and also to allow the user to add as much weight as necessary before the deployment of the bait station.” In other words, the Office is contending that Crossen’s structure should be modified like Faucillon’s structure.

In the last Amendment, Applicant pointed out why it makes no sense to modify Crossen in this manner. First, Applicant pointed out that Faucillon’s bait station does not have a closed bottom with openings (it only has an open-bottomed cage):



The Office now counters that “the bottom of trap (1) of Faucillon is shown to be closed in Fig. 5 since the bottom opening (8) is where the bait is to be placed and that only the top opening (7) is intended for the entry of shellfish into the trap.” Action at 13. This assertion that element number 8 is the claimed one or more openings conflicts with the Office’s earlier assertion on page 9 that element number 26 is the claimed one or more openings. The Board is unforgiving of internal inconsistencies. See *Ex parte O’Brien*, Appeal No. 2002-1846, slip op. at 4-6 (B.P.A.I. Sept. 20, 2002) (non-binding); see also *Ex parte Ronsen*, Appeal No. 2001-1933, slip op. at 10 (BPAI 2003) (non-binding) (addressing Appellant’s assertion of the Office’s failure to comply with MPEP 707.07(d) and stating, “[w]e remind the examiner, in the interest of due process to appellants, that the grounds for rejection of each claim should be delineated with a requisite and reasonable degree of specificity.”). For this reason alone, the rejection should be withdrawn. (To be sure, sleeves 26 are not positioned in a closed bottom of a bait station (they are merely attached to the bottom edge of the side walls of an open-bottomed cage), and recess 8 is not an opening through which any protrusion extends element 1 to element 2.)

Moreover, the two references could not be more different, and Applicant explained why it makes no sense to modify Crossen in view of Faucillon: “There is nothing about Faucillon that would lead one of ordinary skill in the art to modify Crossen’s plastic bait station to have sleeves 26, or to modify weight 120 to have complimentary sleeves 27, so that a pin 28 could be slid through them. That would be an untenable modification of Crossen, given his emphasis on using the central, heavy, harder section 123 of which weight 120 as the attachment point between the bait station and his weight.” August 2009 response at 11. The Office’s view that it is permissible to ignore the actual structure of Faucillon—taking away from Faucillon only the notion of using *some kind* of receptacle with weighted material that is attached to some kind of

trap (*see* Action at 13)—and modify Crossen in some non-specific way to meet the claimed method is not a tenable approach to issuing a sustainable obviousness rejection. The Office cannot ignore Faucillon’s structure or the infeasibility of applying it to Crossen without redesigning both Crossen’s bait station (and Crossen makes clear that he is attempting to use existing bait stations, not design new ones (col. 2, lines 61-65)) and completely eliminating Crossen’s invention (as explained above). As the Board showed recently in the *Greenwald* decision (a mechanical case), it will not sustain such a rejection. *See Greenwald*, slip op. at 6-7 (reversing obviousness rejection and agreeing with appellants that examiner’s proposal to substitute a slot from one reference for a raised portion of the primary reference would have require additional modifications to the primary reference resulting in a nonobvious “substantial reconstruction and redesign”). The rejection is overcome for this additional reason and should be withdrawn.

G. Conclusion

Claims 11 and 12 are in condition for allowance for at least the reasons set forth above, and Applicant does not acquiesce to the Office’s characterizations of the claim language or the cited references. The Examiner is invited to contact Applicant’s attorney with any questions or comments relating to this application.

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